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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,467	08/29/2001	Sterling Mortensen	10004428-1	6476

7590 05/04/2005

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EXAMINER
ZHONG, CHAD

ART UNIT	PAPER NUMBER
2152	

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/941,467	MORTENSEN, STERLING
Examiner	Art Unit	
Chad Zhong	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 15 February 2005.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-30 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-10, 14-25 and 28-30 is/are rejected.
 7) Claim(s) 11-13, 26 and 27 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachments(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. _____.
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____. 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

FINAL ACTION

1. Claims 1-30 are presented for examination.
2. It is noted that although the present application does contain line numbers in specification and claims, the line numbers in the claims do not correspond to the preferred format. The preferred format is to number each line of every claim, with each claim beginning with line 1. For ease of reference by both the Examiner and Applicant all future correspondence should include the recommended line numbering.
3. Applicant is required to update the status (pending, allowed, etc.) of all parent priority applications in the first line of the specification. The status of all citations of US filed applications in the specification should also be updated where appropriate.
4. Claims 11-13, 26-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not teach nor suggest a printer convert print files into files which will be sent to mobile devices by the printer.

AFFIDAVIT 37 CFR 1.131

The affidavit filed on 2/25/2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the McCurdy reference.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the McCurdy reference to either a constructive reduction to practice or an actual reduction to practice.

Diligence is lacking from 6/18/2000, where the HP legal department first received the disclosure to 5/15/2001, when Dicke Billig & Czaja started reviewing the invention disclosure.

A detailed constructive reduction to practice is unavailable, for instance, nowhere in the affidavit was 'mobile computing device' disclosed. Note, an e-book is a digital file, it does not imply the mobility of the computing device; furthermore, computer, printer and e-book can exist locally on one platform, affidavit does not teach nor suggest any indication of a networking environment.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371 (c) of this title before the invention thereof by the applicant for patent.

6. Claims 1-3, 14-20, 22, 28-30 are rejected under 35 U.S.C. 102(e) as being unpatentable over McCurdy et al. (hereinafter McCurdy), US 2002/0035697.

7. As per claim 1, McCurdy teaches a method of distributing an electronic document to a mobile computing device including a display, the method comprising the steps of: translating a data file of the electronic document into a translated data file for the electronic document, including identifying a print format of the electronic document (abstract; [0005]); displaying the electronic document on the display of the mobile computing device, including converting the translated data file for the electronic document into display instructions for the electronic document and displaying the electronic document based on the display instructions in accordance with the print format ([0018]; [0090]; [0095]-[0096]).

8. As per claim 2, McCurdy teaches the method of claim 1, wherein identifying the print format of the electronic document includes identifying at least one of a page margin, a page layout, a paper orientation, and a paper size for the electronic document ([0097]; [0090]).

9. As per claim 3, McCurdy teaches the method of claim 1, wherein the step of translating the data file includes translating the data file of the electronic document into an exchange file format ([0005]; [0261]).

10. As per claim 14, McCurdy teaches the method of claim 1, further comprising the step of: identifying an address of the mobile computing device, wherein the step of transferring the translated data file includes transferring the translated data file for the electronic document to the address of the mobile computing device ([0127]; [0182]).

11. As per claim 15, McCurdy teaches the method of claim 1, wherein the step of transferring the translated data file includes transferring the translated data file for the electronic document to the mobile computing device via a computer associated with the mobile computing device ([02171; [0265]).

12. As per claim 16, McCurdy teaches the method of claim 15, wherein the step of transferring the translated data file includes transferring the translated data file for the electronic document to the computer, and further comprising the step of synchronizing the mobile computing device with the computer, including transferring the translated data file for the electronic document to the mobile computing device from the computer ([0217], [0265], [0343], [0007], [0017], [0078].).

13. As per claim 17-18, claims 17-18 are rejected for the same reasons as rejection to claim 1 above.

14. As per claim 19-20, claims 19-20 are rejected for the same reasons as rejection to claim 2-3 above respectively.

15. As per claim 22, McCurdy teaches the system of claim 18, wherein the processor is part of a

computer ([0374]).

16. As per claims 28-29, claims 28-29 are rejected for the same reasons as rejection to claims 14 15 above respectively.

17. As per claim 30, claims 30 is rejected for the same reasons as rejection to claim 16 above.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 4-10, 24-25 are rejected under 35 U.S.C. 103(a) as unpatentable over McCurdy et al. (hereinafter McCurdy), US 2002/0035697, in view of Beale, "Get prepress-ready PDFs from QuarkXPress" (hereinafter Beale).

20. As per claim 4, McCurdy does not explicitly teach the method of claim 1, wherein the step of translating the data file includes translating the data file of the electronic document into the translated data file for the electronic document via a printer driver.

21. Beale teaches the above for example pg 2, lines 1-10, lines 20-25.

22. It would have been obvious to one of ordinary skill in this art at the time of invention was made to combine the teaching of McCurdy and Beale because they both dealing with format conversion of

electronic document. Furthermore, the teaching of Beale to allow wherein the step of translating the data file includes translating the data file of the electronic document into the translated data file for the electronic document via a printer driver would have accurately preserve the actual document layout, thus the less likelihood layout variation when document is displayed at the mobile device.

23. As per claim 5, McCurdy does not teach the method of claim 4, wherein the step of translating the data file includes translating the data file of the electronic document at a computer including the printer driver and having the data file of the electronic document stored therein. However this issue is addressed in claim 4 above.

24. As per claim 6, McCurdy teaches the method of claim 5, wherein the step of transferring the translated data file includes transferring the translated data file for the electronic document to the mobile computing device from the computer ([0382]).

25. As per claim 7, McCurdy teaches the method of claim 6, further comprising the step of linking the mobile computing device and the computer via a communication link, wherein the step of transferring the translated data file includes transferring the translated data file for the electronic document to the mobile computing device from the computer via the communication link ([0382]).

26. As per claim 8, McCurdy does not teach the method of claim 1, wherein the step of translating the data file includes translating the data file of the electronic document into print instructions for the electronic document and converting the print instructions into the translated data file for the electronic document.

27. Beale teaches the above sections see for example pg 2, lines 20-25.

28. It would have been obvious to one of ordinary skill in this art at the time of invention was made

to combine the teaching of McCurdy and Beale because they both dealing with updating program in the system. Furthermore, the teaching of Beale to allow wherein the step of translating the data file includes translating the data file of the electronic document into print instructions for the electronic document and converting the print instructions into the translated data file for the electronic document. would improve accuracy for McCurdy's system by preserving precise document layout.

29. As per claims 9-10, claims 9-10 are rejected for the same reasons as rejection to claims 4-5 above.

30. As per claims 24-25, claims 24-25 are rejected for the same reasons as rejection to claims 8, 4 above respectively.

31. As per claim 21, claim 21 is rejected for the same reasons as rejection to claim 4 above.

32. As per claim 23, claims 23 is rejected for the same reasons as rejection to claim 7 above.

Conclusion

33. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents and publications are cited to further show the state of the art with respect "DOCUMENT DISTRIBUTION TO MOBILE COMPUTING DEVICE".

- i. US 2002/0184342 Kennedy et al.
- ii. US 5109487 Ohgomori et al.
- iii. US 6442595 Kelly
- iv. US 2003/0035126 Stone et al.
- v. US 2002/0063877 Lucivero et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chad Zhong whose telephone number is (571) 272-3946. The examiner can normally be reached on M-F 7am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A Follansbee can be reached on (571)272-3964. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CZ

April 6, 2005



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